

### **REMARKS**

Applicants thank the Examiner for the thorough examination of the application. The specification has been amended to add headings and to correct minor errors. A Terminal Disclaimer and a certified translation of the priority document are attached to this paper. No new matter is believed to be added to the application by this Amendment.

### **Status Of The Claims**

Claims 1-12 are pending in the application. Claims 5-6 find support at page 4, lines 15-20 of the specification. Claim 7 finds support at page 5, lines 7-9 of the specification. Claim 8 finds support at page 5, lines 10-11 of the specification. Claim 9 finds support at page 5, lines 24-26 of the specification. Claim 10 finds support at page 6, lines 26-27 of the specification. Claim 11 finds support at page 7, lines 4-6 of the specification. Claim 12 finds support at page 10, lines 2-6 of the specification.

### **Double Patenting Rejection**

Claims 1-4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 4, 5, 7-16 and 18 of copending application no. 10/256,139 in view of Corvasce (U.S. Patent 5,672,639). Applicants traverse.

Although the applicants do not agree to the propriety of the rejection, a Terminal Disclaimer of application no. 10/256,139 is being concurrently filed in order to expedite prosecution. This rejection is overcome and withdrawal thereof is respectfully requested.

**Rejections Under 35 U.S.C. §103(a)**

Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP '973 (EP 1 297 973) *or* Tahara (US 2002/0026003) each taken alone or further in view of Corvasce. Applicants traverse.

Regarding, EP '973, this reference was filed on September 26, 2002 and was published on April 2, 2003. In contrast, the present invention claims priority of Japan 2002-216569 filed on July 25, 2002. In order to perfect priority, a certified English translation of Japan 2002-216569 is being filed concurrently with this paper, thus removing EP '973 as prior art to the present invention. Also, it is noted that EP 973 is removable as prior art under the auspices of 35 U.S.C. §103(c).

The remaining rejection under consideration is thus that of Tahara in view of Corvasce.

The present invention pertains to a rubber composition for a pneumatic tire that compounds particles having a Moh's hardness of at least 5 and short fibers together in diene rubber. By doing so, in the step of kneading the short fibers and the particles with

rubber, small scratches are formed on the surface of the short fibers from the friction of the rubbing of the particles having the high Moh's hardness and the short fibers. The short fibers thus are impeded from separating from the rubber base material. Therefore, both improved performance on ice and snow and improved wet gripping properties can be achieved without decreasing the abrasion resistance.

Claim 1 of Tahara sets forth a rubber composition having diene rubber, glass fibers, a reinforcing agent and 1-15 parts by wt. of inorganic powder softer than the glass fibers and having an average particle size of less than 25  $\mu\text{m}$ . Claim 2 of Tahara claims inorganic powders having a Moh's hardness of less than 6.5. However, Table 1 of Tahara discloses inorganic materials having a Moh's hardness of at most 3. The Moh's hardness of 6.5 represents the hardness of glass fibers, as is shown in Table 1 of Tahara. As a result, Tahara is merely claiming a Moh's hardness of less than the glass fibers. Tahara thus fails to disclose or suggest particles (C) having a Moh's hardness of at least 5, as is set forth in claim 1 of the present invention.

At page 3 of the Office Action, the Examiner admits that Tahara fails to disclose a starch/plasticizer component. The Examiner turns to Corvasce for these teachings. However, Corvasce is utterly silent about combining short fibers and particles, and the effect to be obtained therefrom. Corvasce thus fails to address the deficiencies of Tahara in suggesting a claimed embodiment of the present invention.

As a result, one having ordinary skill in the art would not be motivated by Tahara and Corvasce to produce claim 1 of the present invention. A *prima facie* case of obviousness has thus not been made. Claims depending upon claim 1 are patentable for at least the above reasons.

Further, even if one assumes *arguendo* that the combination of Tahara and Corvasce is sufficient to allege obviousness, this obviousness would be fully rebutted by the unexpected results of the invention. These unexpected results are brought about by the interaction of the short fibers with particles having a Moh's hardness of at least 5, as was discussed above. Evidence of these unexpected results can be found in the values for wet gripping property, performance on ice and snow and abrasion resistance set forth in Table 1 at page 15 of the specification. The advantages of the present invention are thus clear.

These rejections are overcome and withdrawal thereof is respectfully requested.

#### **Information Disclosure Statements**

The Examiner is thanked for considering the Information Disclosure Statements filed July 24, 2003 and April 6, 2004 and for making the initialed PTO-1449 forms of record in the application in the Office Action mailed September 6, 2005. However, it is noted that 3 references (JP 11-157303, JP 2002-30183 and JP 200038480) were not initialed in the PTO-1449 form of the Information Disclosure Statement filed July 24,

2003. The Examiner is accordingly respectfully requested to consider these publications and make them of record in the next official action.

### **Conclusion**

The Examiner's rejections have been overcome. No issues remain. The Examiner is accordingly respectfully requested to place the application in condition for allowance and to issue a Notice of Allowability.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Robert E. Goozner, Ph.D. (Reg. No. 42,593) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Application No. 10/625,591  
Amendment dated December 6, 2005  
Reply to Office Action of September 6, 2005

Docket No.: 1403-0253P

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

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Respectfully submitted,

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